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601 S.W SECOND AVENUE
SUITE 1900
PORTLAND, OREGON 97204

TEL: 503.425.6800
FAX: 503.425.6801
www.bannerwitcoff.com

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To:
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FROM:
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YOUR REFERENCE NO.:
10/086,644

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005127.00197

RE:
Request For Reconsideration

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Respectfully submitted,

By:


Thomas L. Evans, PTO Reg. No. 35,805
BANNER AND WITCOFF, LTD.

Atty. Docket No.
005127.00197

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:

Allan M. SCHROCK ET AL.

U.S. Pat. App. No.: 10/086,644

Filed: February 28, 2002

For: PACE CALCULATION WATCH

Examiner: To Be Assigned

Group Art Unit: 2859

REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants respectfully ask for reconsideration of both this application and the Office Action dated August 13, 2004. A response to this Office Action was due by November 13, 2004. On November 15, 2004, however, Applicants submitted a Notice Of Appeal (November 13, 2004 and November 14, 2004, being a Saturday and Sunday, respectively). Accordingly, please accept this Request as timely filed.

Applicants gratefully thank the Examiner for the personal interview granted on December 20, 2004. This content of this Request is being presented in accordance with the substance of that interview.

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In the Office Action of August 13, 2004, the Examiner maintained the rejection of claims 9, 15, 30, and 44 under 35 U.S.C. §112, second paragraph. Applicants again respectfully traverse this rejection, and ask for its reconsideration.

In making this rejection, the Examiner noted that claim 9 does “not include claim language that suggests how the pace calculation system can be applied to a personal digital assistant,” (see Office Action, page 2, lines 13-15), and that claims 15, 30, and 44 do not define the phrase “providing the calculated pace to another device.” As discussed in detail during the interview, Applicants respectfully submit that claims to an invention need not provide a blueprint for constructing specific embodiments of the invention, but must only set forth the metes and bounds of what the inventors believe to be their invention.

It is courteously submitted that one of ordinary skill in the art, upon reading claims 9, 15, 30, and 44, would readily understand the various structures and techniques by which embodiments of the invention could be incorporated into a personal digital assistant. Applicants therefore urge that claim 9 fully complies with the provisions of 35 U.S.C. §112, second paragraph. As agreed to during the interview, Applicants understand that the Examiner will withdraw this rejection for the reasons set forth above.

Next, the Examiner maintained the rejection of claims 1-8, 10-14, 16-29, 31-43 and 45-51 under 35 U.S.C. §103 over U.S. Patent No. 5,050,141 to Thinesen in view of U.S. Patent No. 5,526,290 to Kanzaki. The Examiner also rejected claims 9, 15, 30 and 44 over the combination of the Thinesen and Kanzaki patents, in further view of U.S. Patent No. 5,771,399 to Fishman. Applicants respectfully traverse both of these rejections, and again courteously ask for their

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reconsideration.

Each of claims 1-51 recites the determination of a pace by dividing a distance stored in memory by an elapsed time or a segment of an elapsed time. As described in the specification, the elapsed time is a time period that has already occurred, not a predicted or future time period. Accordingly, the determination of a pace as recited in these claims is not taught or suggested by either Thinesen patent or the Kanazaki patent.

With regard to the Thinesen patent, this patent describes establishing a pace by actuating command buttons in synchronism with the user's footsteps. (See, e.g., column 2, lines 11-14, column 7, lines 38-41, column 8, lines 3-10, etc.). In addition, this patent describes that the pace reflects the number of a user's steps per minute, not upon a distance traveled. (See, e.g., column 6, lines 31-58.) The Thinesen patent does describe multiplying this type of pace by another value to convert it into a unit of distance per time, the accuracy of this calculated distance would be substantially less than the distance recited in the claims, which can be accurately identified before the pace is determined.,

The Kanzaki patent discloses determining a pace in a number of ways, but still does not teach or suggest determining a pace as recited in the claims. First, Kanzaki discloses calculating a target pace at which a user would need to run in order to travel a distance in a target time. (See, e.g., column 8, lines 55-58, column 17, lines 4-20, etc.) Thus, this type of "target" pace cannot be determined based upon an elapsed time. Kanzaki also discloses determining a pace by keying in pace data through a key switch. (See, e.g., column 6, lines 56-57.) Again, this portion of the Kanzaki patent does not teach or suggest determining a pace using an elapsed time. Still further,

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the Kanzaki patent discloses determining a pace by receiving signals from a pedometer. (See column 12, line 61 to column 13, line 25.) Accordingly, the Kanzaki patent does not teach or suggest the features of the invention recited in any of claims 1-51. The Examiner has specifically noted that the Kanzaki patent discloses the general formula for calculating pace as:

$$p=d\div w\div t$$

Applicant respectfully points out, however, that the Kanzaki et al. patent describes using this formula to determine a desired paced based upon a target run time. It does not teach or suggest using an elapsed time to determine an actual pace, as recited in the claims.

Moreover, Applicants respectfully point out that the Kanzaki patent is directed to determining a desired pace for someone to run, while the Thinesen patent is directed to a device for synchronizing a pace produced by the device with the user's actual pace. Thus, in addition to not teaching the features of the invention, the combination of the Thinesen patent with the Kanzaki patent suggested by the Examiner would vitiate the very teachings of the Thinesen patent.

Applicants therefore submit that no combination of the Thinesen and Kanzaki patents would teach or suggested the invention as recited in any of claims 1-51. Further, it is respectfully submitted that the Fishman patent does not remedy the omissions of the Thinesen and Kanzaki patents. Applicants accordingly ask that the rejection of claims 1-51 be withdrawn.

It is respectfully submitted that no fees are due for the consideration of this Request. If, however, the Examiner deems that fees are necessary, including any fees under 37 C.F.R. §1.116 or §1.17, then it is courteously requested that the Examiner charge such fees to the deposit

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account of the undersigned, Deposit Account No. 19-0733.

In view of the above remarks and comments, Applicants respectfully submit that all of the claims are allowable, and that this application is therefore in condition for allowance. Favorable action in this regard is courteously requested at the Examiner's earliest convenience.

Respectfully submitted,

BANNER & WITCOFF, LTD.

By: Thomas L. Evans
Thomas L. Evans, Reg. No. 35,805
1001 G Street, N.W., 11th Floor
Washington, D.C. 20001-4597
Telephone: (202) 508-9100
Facsimile: (202) 508-9299

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